



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/940,265 | 08/27/2001 | Paul A. Smethers | 3399P061 | 4538 |

26529 7590 07/23/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

APPIAH, CHARLES NANA

ART UNIT PAPER NUMBER

2686

DATE MAILED: 07/23/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,265

Applicant(s)

SMETHERS, PAUL A.

Examiner

Charles Appiah

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-4, 6-8, 10-12, 14-19, 21-25 and 27-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Macor (5,841,849).

Regarding claims 1 and 30 Macor discloses a method of operating a hand-held mobile device and a handheld mobile device (see Figs. 1-11), the method comprising: displaying a softkey indicator on a display of the handheld mobile device (26-32), the softkey indicator indicating a corresponding softkey action (see col. 3, lines 24-31), displaying an input field on the display while displaying the softkey indicator (see col. 4, lines 32-49), the input field for displaying characters input by a user using an input device of the handheld mobile device (see col. 4, lines 53-65), detecting activation of the input field (see col. 4, lines 32-65), and in response to activation of the input field, automatically selecting a softkey action previously associated with the input field and automatically changing the softkey indicator to indicate the selected softkey action (see col. 4, line 65 to col. 5, line 8). See Figs. 4-7).

Regarding claims 2-4 and 31-33, Macor further discloses wherein activation of the input field comprises inputting one or more characters in the input field or inputting one

or more characters according to a predefined format in the input field and selecting the input field (see col. 4, 47-65).

Regarding claims 6, 7, 34 and 35, Macor further discloses wherein the input field is a recipient identifier field for receiving an identifier of a recipient of a communication to be initiated from the handheld mobile device, and wherein the softkey action is initiation from the hand-held mobile device of the communication, wherein the communication is a telephone call, and wherein the recipient field is a telephone number input field for receiving a telephone number of party to be called (see Figs. 4-7, col. 4, lines 46-65).

Regarding claims 8, 14, 18 and 24, Macor discloses a method of operating a browser in a handheld mobile device, a handheld mobile device and a machine readable program storage medium having stored therein a browser useable by a handheld device, the method comprising: displaying a telephone number input field on the display of the handheld mobile device (see input fields 42, 150 of Figs. 4-5), the telephone number input field for displaying a telephone number input by a user in response to the user using an input device of the handheld mobile device (see col. 4, lines 46-65), providing a softkey (26-32, 134-140 of Figs. 1 and 3 respectively), including displaying a softkey indicator on the display while displaying the telephone number input field (see col. 3, lines 24-31), the softkey indicator indicating a corresponding softkey action of a plurality of softkey actions of the browser, detecting activation of the telephone number input field (see col. 4, lines 32-49), and in response to activation of the input field, automatically selecting dial action to correspond to the

softkey indicator automatically changing the softkey indicator to indicate the dial action, such that the user can initiate a telephone call from the handheld mobile device by entering the telephone number in the telephone number input field and activating the softkey, without additional input being required from the user to initiate the telephone (see col. 4, line 65 to col. 5, line 4).

Regarding claims 10-12, 15-17, 21-23 and 27-29 Macor further discloses wherein activation of the input field comprises inputting one or more characters in the input field or inputting one or more characters according to a predefined format in the input field and selecting the input field (see col. 4, 47-65).

Regarding claims 19, and 25, Macor further discloses wherein the handheld mobile device is a mobile telephone configured to operate on a wireless network (feature of personal communication device as illustrated in Fig. 1, col. 2, line 45 to col. 3, line 23).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 9, 13, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macor (5,841,849) in view of Inoue et al. (6,332,024).

Regarding claim 5, 9, 13, 20 and 26, Macor fails to explicitly disclose wherein the method is included in a method of executing a browser in the hand-held mobile

device, the browser enabling a user of the hand-held mobile device to navigate hyperlinked content on a data network.

Inoue discloses a portable wireless terminal that includes as illustrated in Figs. 9C, 12, 13A-14F the capability of executing a browser in the handheld device, the browser enabling a user of the handheld mobile device to navigate hyperlinked content on a data network (see col. 3, lines 8-30, col. 16, lines 1-67).

It would therefore have been obvious to one of ordinary skill in the art to combine Inoue's teaching with Macor's communication device in order to realize versatility including Internet browsing capability and downsizing by utilizing minimum entry keys that with significant improvement in usability as taught by Inoue.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi (5,371,779) discloses a call initiating system that displays input data for initiating a call.

Cushman et al. (6,125,287) discloses a wireless telephone having an improved user interface.

Sudo et al. (5,999,827) discloses a communication terminal having a display for displaying an inputted selection operation.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA
July 20, 2004


CHARLES APPIAH
PRIMARY EXAMINER